

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal, should an appeal be necessary. Entry of the amendments is thus respectfully requested.

The Office Action rejects claims 1-3, 5, 6, 8-12, 14, 15, 17-21, 23, 24, 26 and 27 under 35 U.S.C. §102(b) as being anticipated by Zdybel (U.S. Patent No. 5,486,686); and claims 4, 7, 13, 16, 22 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Zdybel. Applicants respectfully traverse the rejections.

In particular, Applicants assert that Zdybel does not disclose or suggest a system for producing and processing a paper document, having at least a token generator that generates user-selectable tokens, and a selector that allows a user to select one or more of the tokens from a list, as recited in independent claim 1, and similarly recited in independent claims 10 and 19.

Zdybel discloses an electronic document processing system that can couple hardcopy outputs to an electronic document from which a human readable hardcopy is produced. See col. 1, lines 11-15. Zdybel enables data which is potentially important to the accuracy and/or completeness of the reconstruction of the electronic source document 32 to be recovered, even if such data is not evident or inferable from the appearance of the human readable rendering of the source document. See col. 10, lines 7-27. The system can be utilized for storing and communicating a machine readable description of all or any selected part of the electronic source document 32, as well as a descriptions of the equipment in process employed for producing the source document 32 and the human readable rendering 45. See

col. 10 lines 40-45. Documents can be printed to include digitally embedded data descriptions and can be distributed by mail. See col. 10 lines 55-60.

In stark contrast to Applicants' claimed invention, Zdybel does not disclose or suggest a system for producing and processing a paper document, having at least a token generator that generates user-selectable tokens, and a selector that allows a user to select one or more of the tokens from a list. On the contrary, Zdybel only discloses that the system can be utilized for determining which machine readable descriptions will be stored and communicated when producing the document, but not when recreating the document.

Furthermore, the system in Zdybel discloses that glyph encoded data may be embedded in the hardcopy document 102. However, nowhere in Zdybel is it disclosed that a token generator generates user-selectable tokens on the paper document so that a selector may be used to allow a user to select one or more of the user-selectable tokens from a list when recreating the document. Because Zdybel fails to disclose its features, Zdybel does not allow a user to individually select tokens that represent references, documents, services and/or programs that have been gathered and inputted into individual user-selectable tokens at the token generator. Thus, Applicants assert that it is not an inherent feature in Zdybel to have a selector that allows a user to select one or more tokens from list.

Accordingly, because Zdybel fails to disclose this feature, Applicants assert that independent claims 1, 10 and 19 define patentable subject matter. Claims 2-9, 11-18 and 20-27 depend from independent claims 1, 10 and 19, respectively, and therefore also define patentable subject matter for at least these reasons as well as for the additional features they recite. Therefore, Applicants respectfully request that the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) be withdrawn.

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-27 are earnestly solicited.

Should the Examiner believed anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' attorney at the telephone number listed below.

Respectfully submitted,



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Attachment:
Appendix

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<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 24-0037</p>

APPENDIX

Changes to Claims:

The following is a marked-up version of the amended claims:

1. (Three-Times Amended) A system for producing and processing a paper document, comprising:

a token generator that generates user-selectable tokens relating to at least one other document, the other document being an electronic document, for purposes of linking the other document;

an encoder that encodes the generated tokens; and

a printer that prints the encoded tokens onto the paper document; and

a selector that allows a user to select one or more tokens from a list.

~~wherein the tokens are generated so that a user can individually select which tokens to access.~~

10. (Three-Times Amended) A system for producing and processing a paper document, comprising:

token generating means for generating user-selectable tokens relating to at least one other document, the other document being an electronic document, for purposes of linking the other document;

encoding means for encoding the generated tokens; and

printer means for printing the encoded tokens onto the paper document; and

a selector means for selecting one or more of the user-selectable tokens from a list.

~~wherein the tokens are generated so that a user can individually select which tokens to access.~~

19. (Three-Times Amended) A method for producing and processing a paper document, comprising:

generating user selectable tokens relating to at least one other document, the other document being an electronic document, for purposes of linking the other document;

encoding the generated tokens; and

printing the encoded tokens onto the paper document; and

Selecting one or more of the user-selectable tokens from a list.

~~wherein the tokens are generated so that a user can individually select which tokens to access.~~